

REMARKS/ARGUMENTS

The rejections presented in the Office Action dated January 19, 2007 (hereinafter “Office Action”) have been considered. Claims 1-21 remain pending in the application. Reconsideration of the pending claims and allowance of the application in view of the present response is respectfully requested.

Applicant appreciates the indication of allowability for Claims 5-9 and 14-18.

Claim 21 has been amended to correct a typographical error; the changes were not made for any reasons related to patentability.

Applicant respectfully traverses each of the §103(a) rejections based at least in part upon the teachings of U.S. Patent No. 6,835,013 to Dunn *et al.* (hereinafter “Dunn”) in view of the teachings of U.S. Publication No. 2004/0158429 to Bary *et al.* (herein after “Bary”) because the asserted references, alone or in combination, do not teach or suggest each of the claimed limitations. Rather, Dunn appears to be unrelated to the claimed invention as Dunn is directed to a label printer. More specifically, Dunn does not teach displaying a character string on a touchscreen, as claimed in each of the independent claims. Instead, Dunn indicates that display 108 is a liquid crystal display (column 3, lines 1-2). The only mention of a touchscreen in the cited portions of Dunn refers to input means, not a display for a character string (column 3, lines 5-8). Moreover, the reliance on Fig. 5 of Dunn is misplaced as Fig. 5 refers to an edit buffer, not a display. For example, reference numeral 212 cited on page two of the Office Action refers to invisible data such that “the data is stored in the edit buffer 200 but is not displayed” (column 7, lines 19-22). As Bary does not teach or suggest at least any use of a touchscreen, any combination of these asserted teachings would fail to teach displaying a character string on a touchscreen, as claimed. Without a presentation of correspondence to each of the claimed limitations, the §103(a) rejections are improper. Applicant accordingly requests that each of the rejections be withdrawn.

Further, the Examiner acknowledges that Dunn does not teach at least an indicator means for making an indication such that the characters after the indication point are deleted from the character string, as claimed. In an attempt to overcome this deficiency, the

teachings of Bary are relied upon. However, the relied upon portion of Bary is directed to identifying certain characters present in a URL to modify the URL to its lowest denominator. As the certain characters (session id) are already present in the URL, Applicant fails to recognize how Bary would teach editing a character string in response to an indication made with the indicator means. The Examiner has not identified what is asserted as corresponding to the “indicator means” or how such teaching is used to make an indication. Without a presentation of correspondence to each of the claimed limitations, the §103(a) rejections are improper, and Applicant requests that they be withdrawn.

Dependent Claims 2, 11 and 21 depend from independent Claims 1, 10 and 20, respectively. Each of these dependent claims also stands rejected under 35 U.S.C. §103(a) as being unpatentable over the above-discussed combination of Dunn and Bary. While Applicant does not acquiesce to any particular rejections to these dependent claims, including any assertions concerning descriptive material, obvious design choice and/or what may be otherwise well-known in the art, these rejections are moot in view of the remarks made in connection with independent Claims 1, 10 and 20. These dependent claims include all of the limitations of their respective base claims and any intervening claims and recite additional features which further distinguish these claims from the cited references. “If an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious.” MPEP §2143.03; *citing In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Therefore, dependent Claims 2, 11 and 21 are also allowable over the combination of Dunn and Bary.

With respect to the §103(a) rejections of dependent Claims 3, 4, 12 and 13 based upon the asserted combination of Dunn and Bary in further view of U.S. Patent No. 6,470,027 to Birrell and Japanese Patent No. JP 02-204848A to Iwata, respectively, Applicant respectfully traverses. As discussed above, the asserted combination of Dunn and Bary fails to correspond to the limitations of independent Claims 1 and 10 (from which Claims 3, 4, 12 and 13 depend). The Examiner’s further reliance on Birrell and Iwata does not overcome the above-discussed deficiencies in the underlying combination of references. Thus, the asserted combinations of the teachings of Dunn and Bary with Birrell and Iwata

do not teach each of the claimed limitations of dependent Claims 3, 4, 12 and 13, and the rejections should be withdrawn.

In addition to having to show that the asserted combination of references teaches or suggests all of the claim limitations, the Examiner must show evidence of motivation to combine these references as asserted. Applicant respectfully submits that this requirement has not been met.

The requisite evidence of motivation to combine the teachings of Dunn and Bary as asserted has not been presented, nor does such motivation exist based on the cited references. In the Office Action, the proffered motivation to combine the teachings of Dunn and Bary is “to correlate the content issues with the traffic data.” This is not evidence of motivation to combine Bary with the teachings of Dunn but rather, is a generalized statement of what is taught by Bary. Dunn makes no reference to content issues or traffic data as Dunn is directed to a label printer. No evidence has been provided that a skilled artisan would have attempted to introduce the URL normalization options of Bary to the label printer taught by Dunn.

The examiner must show some objective teaching leading to the asserted combination. *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988). Since Dunn makes no reference to URLs, and neither Dunn nor Bary teach using a touchscreen to display a character string, as discussed above, it is respectfully submitted that the teachings of Bary and Dunn would have provided insufficient guidance for a skilled artisan having these references before him/her to make the combination suggested by the Examiner. Applicant respectfully asserts that the Examiner’s conclusion of obviousness is, instead, based on improper hindsight reasoning using knowledge gleaned only from Applicant’s disclosure. As stated by the Federal Circuit:

Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight.

In re Dembiczak, 50 USPQ2d 1614, (Fed. Cir. 1999) (*citing Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985)). Without a suggestion of

the desirability of “the combination,” a combination of such references is made in hindsight, and the “range of sources available, however, does not diminish the requirement for actual evidence.” *Id.* It is a requirement that actual evidence of a suggestion, teaching or motivation to combine prior art references be shown and that this evidence be “clear and particular.” *Id.* Broad conclusory statements regarding the teaching of multiple references, standing alone, are not evidence. *Id.*

As Dunn does not teach any use of URLs, Applicant respectfully submits that the asserted combination simply does not contemplate the proposed combination. This piecemeal selection of elements is tantamount to mixing teachings out of context. Such a rejection is not permissible under §103. *See In re Kotzab*, 217 F.3d 1365 (Fed. Cir. 2000) (proposed modification must not be made in the abstract but rather made in view of the entire teaching of the prior art).

There is nothing in the references or what is in the ordinary skill in the art that would lead to combining the cited references as asserted – rather, the proffered motivation is made in hindsight. For at least the aforementioned reasons, Applicant respectfully submits that a case of *prima facie* obviousness has not been satisfied for lack of a presentation of evidence of motivation to combine the cited references. Applicant accordingly requests that the rejections be withdrawn.

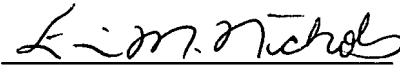
It should be noted that Applicant does not acquiesce to the Examiner’s statements or conclusions concerning what would have been obvious to one of ordinary skill in the art, obvious design choices, common knowledge at the time of Applicant’s invention, officially noticed facts, and the like. Applicant reserves the right to address in detail the Examiner’s characterizations, conclusions, and rejections in future prosecution.

Authorization is given to charge Deposit Account No. 50-3581 (KOLS.094PA) any necessary fees for this filing. If the Examiner believes it necessary or helpful, the undersigned attorney of record invites the Examiner to contact her at the number below to discuss any issues related to this case.

Respectfully submitted,

HOLLINGSWORTH & FUNK, LLC
8009 34th Avenue South, Suite 125
Minneapolis, MN 55425
952.854.2700

Date: April 16, 2007

By: 

Erin M. Nichols
Reg. No. 57,125